

Status of the Application

Claims 1-6 and 8 are pending in the present application. The following rejection is currently at issue: Claims 1-6 and 8 are rejected under 35 U.S.C. §103(a), as allegedly obvious over Cook et al. (U.S. Pat. No. 5,554,646) in view of applicants' disclosure at page 11, line 13-25, Cain et al. (WO 97/18320), Chin et al. and Baltes et al. (U.S. Pat. No. 3,162,658). Claims 3 was objected to because of a typographical error. This error has been corrected and is not believed to affect the scope of the claims.

Applicants believe that the present amendments and the following remarks traverse the Examiner's rejection of the claims.

REMARKS

1. The Applicants Previous Arguments Stand Unrebutted

At the outset, Applicants respectfully note that several of the arguments presented in their previous Response dated May 6, 2003 stand unrebutted or were simply ignored by the Examiner. First, Applicants submitted evidence as to why *In re Michalek* does not apply to the facts of the present case where actual experimental evidence is provide to the Office. The Examiner has failed to respond to this argument and simply repeated his previous statements. Second, Applicants submitted arguments regarding evidence that the Examiner is *required* to consider according to the Supreme Court precedent provided in *Graham v. Deere*. Again, the Examiner has failed to respond to this argument. Third, Applicants submitted an argument regarding reasonable expectation of success. Instead of actual addressing the merits of the argument, the Examiner merely states that "there is no evidence to dispute the validity of the data disclosed by Cain et al." This statement fails to be responsive to Applicants arguments. The Examiner's failure to address these arguments necessitates that they be incorporated by reference in this response.

Accordingly, Applicants specifically request that the arguments be addressed. Indeed, it is the Office's duty to properly consider these arguments. The MPEP states that:

Office personnel should consider all rebuttal arguments and evidence presented by applicants. . . . *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992). . . . Office personnel should avoid giving evidence no weight, except in rare circumstances. *Id.* See also *In re Alton*, 76 F.3d 1168, 1174-75, 37 USPQ2d 1578, 1582-83 (Fed. Cir. 1996).

* * *

A determination under 35 U.S.C. 103 should rest on **all the evidence** and should

not be influenced by any earlier conclusion. *See, e.g., Piasecki*, 745 F.2d at 1472-73, 223 USPQ at 788; *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Thus, once the applicant has presented rebuttal evidence, Office personnel should **reconsider** any initial obviousness determination in view of the entire record. *See, e.g., Piasecki*, 745 F.2d at 1472, 223 USPQ at 788; *Eli Lilly*, 902 F.2d at 945, 14 USPQ2d at 1743.¹

Additionally, the Courts have held as follows:

When *prima facie* obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over An earlier decision should not . . . be considered as set in concrete, and applicant's rebuttal evidence then be evaluated only its knockdown ability. Analytical fixation on an earlier decision can tend to provide the decision with an undeservedly broadened umbrella effect. *Prima facie* obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself. Though the tribunal must begin anew, a final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached . . . upon a different record.²

Furthermore:

If a *prima facie* case is made in the first instance, and if the applicant comes forward with a reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed.³

Accordingly, even if the Examiner had established a *prima facie* of obviousness in the preceding Office Action (and Applicants contend that he did not), the Examiner must respond to the arguments and evidence presented by the Applicants. **There was no reweighing of the merits by the Examiner.**

2. The Cited References Do Not Teach Each Element of the Claims

A *prima facie* case of obvious requires that the cited references teach each element of the claims. *See, e.g., Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990). As detailed in the Declaration of Asgeir Sæbo, the cited references do not teach methods capable of producing the claimed compositions. In response to this objective data, the Examiner states that the "examiner is not convinced by the assumption that Cain et al. cannot detect the

¹ MPEP §§2144.08; emphasis added).

² *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

³ *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986).

trans trans isomers, or simply ignore the presence of the isomers. The evidence provided with the declaration has been fully evaluated against the cited reference. Applicants provided results contrary to the references, making assumption without factual support."

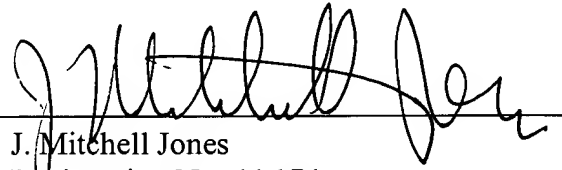
Applicant respectfully submits that these statements indicate that the Examiner has completely misinterpreted the Declaration of Mr. Asgeir Sæbo. **The Declaration is not based on assumption, it is based on fact.** Mr. Asgeir Sæbo repeated the conditions disclosed in the cited references and analyzed the products. The actual gas chromatography results are provided.

This is **factual** evidence - not assumptions! Indeed, the Examiner is the party engaging in assumptions by assuming that Cain's and Cook's silence with respect to the disputed isomers means that they were necessarily absent. The Examiner has provided **no factual support** for this argument. Accordingly, Applicants respectfully submit that the cited references do not teach element of the claims. Thus, the Examiner has not established a *prima facie* case obviousness. Applicants request that the claims be passed to allowance.

Conclusion

All grounds of rejection and objection of the Office Action of July 24, 2003 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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